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09/236,373	01/25/1999	BRUCE A. BUHLER	71-673-1	1565

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STEVEN W WEINRIEB
SCHWARTZ 7 WEINRIEB
2001 JEFFERSON DAVIS HWY
CRYSTAL PLAZA ONE SUITE 1109
ARLINGTON, VA 22202

EXAMINER

PRICE, CARL D

ART UNIT

PAPER NUMBER

3743

DATE MAILED: 03/06/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary**Application No.**

09/236,373

Applicant(s)

BUHLER, BRUCE A.

Examiner

Carl D. Price

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 12 July 2001 and 05 November 2001 .

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-3 and 5-26 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-3 and 5-26 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 12.

4) Interview Summary (PTO-413) Paper No(s) _____.
5) Notice of Informal Patent Application (PTO-152)
6) Other: _____

Reissue Application

Continued Prosecution Application

The request filed on 07-12-2001 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/236,373 is acceptable and a CPA has been established. An action on the CPA follows.

Continuing Obligation under 37 CFR 1.56

Applicant is reminded of the continuing obligation under 37 CFR 1.56 to timely apprise the Office of any litigation information, or other prior or concurrent proceeding, involving Patent No. 5,755,568, which is material to patentability of the claims under consideration in this reissue application. This obligation rests with each individual associated with the filing and prosecution of this application for reissue. See MPEP §§ 1404, 1442.01 and 1442.04.

Lacking the Written Consent - 37 CFR 1.172(a)

This application is objected to under 37 CFR 1.172(a) as lacking the written consent of all assignees owning an undivided interest in the patent. The consent of the assignee must be in compliance with 37 CFR 1.172. See MPEP § 1410.01.

While the statement under 37 CFR 3.73(b) is acceptable, it does not include the separate requirement of the written consent.

A proper assent of the assignee in compliance with 37 CFR 1.172 and 3.73 is required in reply to this Office action.

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§ 1.172 Applicants, assignees

(a) A reissue oath must be signed and sworn to or declaration made by the inventor or inventors except as otherwise provided (see §§ 1.42, 1.43, 1.47), and must be accompanied by the written consent of all assignees, if any, owning an undivided interest in the patent, but a reissue oath may be made and sworn to or declaration made by the assignee of the entire interest if the application does not seek to enlarge the scope of the claims of the original patent. All assignees consenting to the reissue must establish their ownership interest in the patent by filing in the reissue application a submission in accordance with the provisions of § 3.73(b) of this chapter.

(b) A reissue will be granted to the original patentee, his legal representatives or assigns as the interest may appear.

§ 3.73 Establishing right of assignee to take action.

(b)(1) In order to request or take action in a patent or trademark matter, the assignee must establish its ownership of the patent or trademark property of paragraph (a) of this section to the satisfaction of the Commissioner. The establishment of ownership by the assignee may be combined with the paper that requests or takes the action. Ownership is established by submitting to the Office a signed statement identifying the assignee, accompanied by either:

(i) Documentary evidence of a chain of title from the original owner to the assignee (e.g., copy of an executed assignment). The documents submitted to establish ownership may be required to be recorded pursuant to § 3.11 in the assignment records of the Office as a condition to permitting the assignee to take action in a matter pending before the Office; or

(ii) A statement specifying where documentary evidence of a chain of title from the original owner to the assignee is recorded in the assignment records of the Office (e.g., reel and frame number).

(2) The submission establishing ownership must show that the person signing the submission is a person authorized to act on behalf of the assignee by:

(i) Including a statement that the person signing the submission is authorized to act on behalf of the assignee; or

(ii) Being signed by a person having apparent authority to sign on behalf of the assignee, e.g., an officer of the assignee.

Surrender of the Original Patent

It is noted that this reissue application was filed with the required offer to surrender the original patent or, if the original is lost or inaccessible, an affidavit or declaration to that effect. The original patent, or an affidavit or declaration as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

DEFECTIVE DECLARATION

The reissue oath/declaration filed with this application is defective (see 37 CFR 1.175 and MPEP § 1414) because of the following: The declaration must be signed by the inventors when the claims have been broadened. Also, the inventor's residence, mailing address and country of citizenship have not been provided.

Broadened Reissue Claims

A claim is broader in scope than the original claims if it contains within its scope any conceivable product or process which would have infringed the original patent. A claim is broadened if it is broader in any one respect even though it may be narrower in other respects. Note that in the Reissue Declaration applicant is attempting to broaden the claims based on 1) deleting the phrase "said inner peripheral surface having several ... spaced from one another," (claim 9(amended), line 14-17), 2) deleting the term "point" (claim 6(amended)), 3) deleting the terms "extends trough", "point" and "angularly" (claim 11(amended)), 4) deleting the terms "oxygen passageway", "oxygen control means" (claim 13) and 5) the first and second closed ends of the torch tip head" (claim 9).

Claims Rejected - Defective Declaration

Claims 1-3 and 5-26 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

DETAILED ACTION

Amendments have been entered

Amendments submitted by applicant on filed 11-01-2000, 7-18-2001 and 11-05-2001 have all been entered.

Claims 1-3 and 5-26 remain under examination in the application.

Claim 4 has been canceled as directed by applicant in paper filed on 07-18-2001.

The amendment filed 11-01-2000 proposes amendments to claim 24 that do not comply with 37 CFR 1.173(b), which sets forth the manner of making amendments in reissue applications. Applicant is required to present claim 24 as amended in a form including the entire text of the claim with markings showing any changes made to the claim.

Amendments to claims in a Reissue Application:

An amendment paper must include the entire text of each claim being changed by such amendment paper and of each claim being added by such amendment paper. For any claim changed by the amendment paper, a parenthetical expression "amended," "twice amended," *etc.*, should follow the claim number. Each changed patent claim and each added claim must include markings pursuant to paragraph (d) of this section, except that a patent claim or added claim should be canceled by a statement canceling the claim without presentation of the text of the claim.

All amendment changes must be made relative to the patent to be reissued. Pursuant to 37 CFR 1.173(d), any such changes which are made to the specification, including the claims, must be shown by employing the following "markings:"

(A) The matter to be omitted by reissue must be enclosed in brackets; and

(B) The matter to be added by reissue must be underlined, except for amendments submitted on compact discs (pursuant to 37 CFR 1.96 for computer printouts or programs, and 37 CFR 1.825 for sequence listings). Matter added by reissue on compact discs must be preceded with "U>" and end with "<U>" to properly identify the material being added.

Response to Arguments

Applicant's arguments with respect to claims 1-3 and 5-26 have been considered but are moot in view of the new ground(s) of rejection.

Applicant argues that the prior of record fails to show features of the invention now set forth in the amended claims. In particular, applicant states that in the present invention "the arcuate extent of the tip head is now claimed as being within the range of 240°- 280° so as to facilitated the insertion of the member to be heated into the interior of the tip head through a side portion of the tip head". Prior art references such as Weiner et al (figure 5), Wetzler, Japanese '129 (JP 63-55129), Japanese '524 (JP 6-313524), Japanese '917 (JP 7-145917), Japanese '310 (JP 56-142310), Japanese '609 (JP 56-77609) are either relied on to directly address the limitations of applicant's invention as now expressed in the amended claims, or are included for review by applicant as prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the ports being angularly oriented to generate flames extending from first to a second plane, etc. and the flames projecting "outwardly" with respect to the first plane to achieve heating along the second plane (see, for example, the last paragraph of claim 1 (amended)) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

a. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of 37 CFR 1.71(a)-(c):

(a) The specification must include a written description of the invention or discovery and of the manner and process of making and using the same, and is required to be in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which the invention or discovery appertains, or with which it is most nearly connected, to make and use the same.

(b) The specification must set forth the precise invention for which a patent is solicited, in such manner as to distinguish it from other inventions and from what is old. It must describe completely a specific embodiment of the process, machine, manufacture, composition of matter or improvement invented, and must explain the mode of operation or principle whenever applicable. The best mode contemplated by the inventor of carrying out his invention must be set forth.

(c) In the case of an improvement, the specification must particularly point out the part or parts of the process, machine, manufacture, or composition of matter to which the improvement relates, and the description should be confined to the specific improvement and to such parts as necessarily cooperate with it or as may be necessary to a complete understanding or description of it.

The specification is objected to under 37 CFR 1.71 because, for example, the ports being angularly oriented to generate flames extending from first to a second plane, etc. and the flames projecting "outwardly" with respect to the first plane to achieve heating along the second plane (see, for example, the last paragraph of claim 1 (amended)) was not described in the specification as originally filed.

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The amendment filed 11-01-2000 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: For example, the ports being angularly oriented to generate flames extending from first to a second plane, etc. and the flames projecting "outwardly" with respect to the first plane to achieve heating along the second plane (see, for example, the last paragraph of claim 1 (amended)) was not described in the specification as originally filed.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claims 1-3 and 5-26 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. For example, the ports being angularly oriented to generate flames extending from first to a second plane, etc. and the flames projecting "outwardly" with respect to the first plane to achieve heating along the second plane (see, for example, the last paragraph of claim 1 (amended)) was not described in the specification as originally filed.

35 U.S.C. 112, second paragraph

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 1-3 and 5-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claims 1,9,13,1620 and 23, the phrase "to project flames outwardly there from at a predetermined angle" causes the claim to be indefinite since it is unclear what direction would necessarily constitute "outwardly". All of the claims should be reviewed for further and similar informalities.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3 and 5-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over JAPANESE '310 (figures 1 and 2) or JAPANESE '570 in view of WIENER (figures 2,4 and 5) and Falk et al (of record).

JAPANESE '310 (newly cited) and JAPANESE '570 (of record) disclose the invention substantially as set forth in the claims with possible exception to the curve of the torch head extending through between 240 and 280 degrees, the torch head having separate fuel gas and

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oxygen supply passages therein and control means on the torch head and associated with each of the fuel gas and oxygen passages to selectively block the flow there through.

JAPANESE '310 and JAPANESE '570 show and/or disclose torch heads and handles having separate fuel gas and oxygen supply passages therein and control means on the torch head and associated with each of the fuel gas and oxygen passages to selectively block the flow there through. Japanese '310 includes a tip stem (4) communicating with a fuel/oxygen passage and connected to an arcuate shaped tip head (Figures 1,2) and having at least a first, second and third angularly spaced orifices (2) which open toward a common point. And, JAPANESE '310 discloses and shows flames directed angularly from a first burner head plane to a second heater member intersecting plane (figure 2). JAPANESE '570 shows at least a first, second and third angularly spaced orifices (2) which open toward a common point.

WIENER ET AL teaches (figure 5; column 3, line 69 - column 4, line 2 and column 4, lines 60-72), from the same torch head field of endeavor as JAPANESE '310 and JAPANESE 570, selectively forming the semi-circular segment (52) of the burner head to accommodate, through an arcuate distance to defined a gap to facilitate the insertion of the member to be heated into the interior of the tip head through a side portion of the tip head.

Falk et al teaches, from the same torch head field of endeavor as JAPANESE '310, JAPANESE '570, forming an integral torch head and handle tube (11) to include separate fuel gas and oxygen supply passages (21,25) therein and control means (40,55) on the torch head and associated with each of the fuel gas and oxygen passages to selectively block or control the flow there through. Falk et al includes a tip stem (29) communicating with the fuel and oxygen passages and connected to a tip head (34) having a flame orifice.

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In regard to claims 1-3 and 5-26, for the purpose of facilitating the insertion of the member to be heated into the interior of the tip head, it would have been obvious to a person having ordinary skill in the art to dimension the arcuate dimensions of JAPANESE '310 and JAPANESE '570 to accommodate passage of the member to be heated through a side portion of the tip head, in view of the teaching of WIENER ET AL. And, for the purpose of forming an integral torch head and handle tube, it would have been obvious to one with ordinary skill in the art to modify the torch head and handle of JAPANESE '310 and JAPANESE '570, to include a integral torch head and handle tube having separate fuel gas and oxygen supply passages therein and control means on the torch head/handle tube associated with each of the fuel gas and oxygen passages to selectively block or control the flow there through, in view of the teaching of Falk et al. In regard to JAPANESE '570, in particular, it would have been obvious to a person having ordinary skill in the art to modify the gas ports to be in the form of a single row of ports, in view of the teaching of JAPANESE '310. In regard to claims 1-3 and 5-26, since the number, relative orientation, spacing, burner arc length, etc. would depend on numerous design concerns such as the such as the size or circumference of an article to be heated, the type of fuel burned, the amount of heat to be applied to the article heated, the flame size, the desired distribution of heat over the heated surface, etc., to space the orifices at an angle of 100 degrees, an angle of 120 degrees, less than about 280 degrees, at least about 245 degrees, attaching the stem at a point midway between a second and third orifice, etc. can be viewed as nothing more than mere matters of choice in design absent the showing of any new or unexpected results produced there from over the prior art of record. Also, the recitation "for heating a member attendant a metal bonding operation" has not been given patentable weight because the recitation occurs in the preamble. A

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preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hiram*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). And, the claim limitation that heating is “within and along said second plane, attendant a metal bonding operation to be achieved along said second plane.”, is a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Wetzler, Japanese '040 (JP 62-29040), Japanese '129 (JP 63-55129), Japanese '524 (JP 6-313524), Japanese '917 (JP 7-145917), Japanese '609 (JP 56-77609), Japanese '042 (JP 42-42042), Doyle (figures 3,7), Barnes et al, Brookins et al (figures 1,2,5,8), Farnsworth et al (figure 3) and Bailey (figures 8,10) all show curved torch tips attached to torch heads.

Harris shows a torch tip and handle with oxygen and fuel supply conduits, control valves and fittings.

USPTO CUSTOMER CONTACT INFORMATION

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CARL D. PRICE whose telephone number is 703-308-1953. The examiner can normally be reached on Monday through Friday between 6:30am-3:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry Bennett can be reached on 703-308-0101. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 308-1148/0858.



CARL D. PRICE
Primary Examiner
Art Unit 3743

cp
February 21, 2002